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10/686,476	10/15/2003	James Timothy Stolzer	PTG 02-18-3	6646
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SUITER WEST PC LLO 14301 FNB PARKWAY SUITE 220 OMAHA, NE 68154				
EXAMINER PRONE, JASON D				
ART UNIT 3724			PAPER NUMBER	

DATE MAILED: 12/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/686,476

Applicant(s)

STOLZER, JAMES TIMOTHY

Examiner

Jason Prone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 7,9,15,17,24 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8,10-14,16,18-23 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 05 February 2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Species A in the amendment filed 23 September 2004 is acknowledged.
2. Claims 7, 9, 15, 17, 24, and 26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **with** the amendment filed 23 September 2004.

### ***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: On page 6 line 18, item "308". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.
4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "104", "204" and "304" have both been used to designate

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the threaded rod. The reference characters "102" and "202" have both been used to designate the housing. The reference characters "114" and "214" have both been used to designate the housing recess. The reference characters "106", "206", "306", and "406" have both been used to designate the retaining member. The reference characters "108" and "308" have both been used to designate the tabs. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Claim Objections***

5. Claims 1 and 3 are objected to because of the following informalities: on the second to last line of each claim the phrase "is capable of capable of pivotally" should be replaced with "is capable of pivotally". Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regards to claims 1 and 2, the phrases "a securing mechanism connected to the retention member", on line 3 of claim 1, and "the retention member further includes a friction lock", on lines 1-2 of claim 2, are unclear. It is uncertain if the friction lock and the securing mechanism are the same thing but, as claimed, the friction lock and the securing mechanism are considered two separate structures. The only device disclosed that secures/locks the retention member are the tabs. If the securing mechanism is assumed to be the tabs it is unclear what the structure the friction lock represents. If the friction lock is assumed to be the tabs it is unclear what structure the securing mechanism is representing.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1 and 2 are rejected, as best understood under 35 U.S.C. 102(b) as being anticipated by Vold (3,083,744).

Vold discloses the same invention including an adjustable retention member for providing work piece positioning (31), a securing mechanism connected to the retention member for securing the retention member in a desired orientation (29), that the

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retention member is capable of pivotally obtaining an extended orientation (Fig. 4) and a retracted orientation (Fig. 5), and a friction lock for locking the retention member in a desired position (33).

10. Claims 3-6, 10, 11, 13, 14, and 19-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Windstrup (4,423,860).

In regards to claims 3-6 and 10:

Windstrup discloses the same invention including an adjustable positioning device (40), a retention member connected to the adjustable positioning device (20), a securing mechanism connected to the retention member for securing the retention member in a desired orientation (14), that the retention member is capable of pivotally obtaining an extended orientation and a retracted orientation (Fig. 7), a deck housing the adjustable device, the retention member, and the securing mechanism (12), that the deck supports a work piece (12), that the retention member is pivotally extending exterior to the deck and retracting into the deck (Fig. 7), that the adjustable positioning device is a threaded rod (40), that the retention member includes an aperture (22) with segmented threads for pivotally engaging the threaded rod (42 and 44), and that the apparatus is capable of being integrated with a power tool (1).

In regards to claims 11, 13, 14, 18, and 19:

Windstrup discloses the same invention including a housing (12) including a recess (Fig. 2), an adjustable positioning device disposed in the housing (40), a retention member connected to the adjustable positioning device (20), that the retention member is configured to pivotally obtain an extended orientation and a retracted

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orientation (Fig. 7), a securing mechanism connected to the retention member for securing the retention member in a retracted orientation (14), that the retention member is capable of pivotally extending exterior to the housing and retracting into the housing recess (Fig. 7), that the adjustable positioning device is a threaded rod (40), that the retention member includes an aperture (22) with segmented threads for engaging the threaded rod (42 and 44), that the housing is capable of being included in a work deck (12), and that the apparatus is capable of being integrated with a power tool (1).

In regards to claims 20-23:

Windstrup discloses the same invention including a means for adjustable positioning (40), a means for retaining pivotally adjustably connected to the positioning means (20), a means for securing the retaining means connected to the retaining means (14), that the retaining means is capable of obtaining an extended orientation and a retracted orientation (Fig. 7), that the adjustable positioning means is a threaded rod (40), and wherein the retaining means is a cleat (20).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 8, 16, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Windstrup in view of Wilson et al. (5,146,832). Windstrup discloses the invention including that the securing mechanism is a pair of generally opposing tabs (14) but fails

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to disclose that the tabs are deformable. Wilson et al. teaches that it is old and well known to incorporate deformable tabs (Claim 1). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Windstrup with deformable tabs, as taught by Wilson et al., to make the retention member more durable and less likely to break if the device became jammed.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Trepte, Jordan, Shepp, Price, Scott et al., Bernier, Robert, and Chen.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is 571-272-4513. The examiner can normally be reached on 7:30-5:00, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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A handwritten signature, possibly reading "JP", in dark ink.

JP  
November 19, 2004

A handwritten signature, possibly reading "Allan N. Shoap", in dark ink.

Allan N. Shoap  
Supervisory Patent Examiner  
Group 3700